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09/879,905	06/14/2001	Yasuhiro Shimada	35.C15451	5559

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EXAMINER

YAM, STEPHEN K

ART UNIT PAPER NUMBER

2878

DATE MAILED: 12/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/879,905

Applicant(s)

SHIMADA ET AL.

Examiner

Stephen Yam

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5,7 and 9-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7 and 9-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This action is in response to Amendments and remarks filed on September 25, 2002. Claims 1-5, 7, and 9-23 are currently pending.

#### ***Claim Objections***

1. Claims 17 and 20 are objected to because of the following informalities:

"The surface observation apparatus" should be replaced by "A surface observation apparatus" for proper antecedent basis.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1, line 7, it appears that Applicant intended to insert an existing component, possibly "hollow cantilever" or "hollow waveguide", after "the end of said". Since a plurality of possible components can be inserted, it is unclear what Applicant is claiming.

#### ***Claim Rejections - 35 USC § 102***

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 17-19 (as dependent from Claim 1), and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Brezoczky et al. US Patent No. 5,351,229.

Regarding Claim 1, Brezoczsky et al. teach (see Fig. 5) a probe for detecting or irradiating light comprising a cantilever (49) supported at an end thereof by a substrate (19) (see Fig. 1), a hollow tip (51) formed at a free end of said cantilever, a microaperture (bottom end of 75) formed at the end of said tip, a hollow waveguide (76) formed inside said cantilever, and a mirror (61) at an end of said hollow waveguide at the tip side, wherein the end of the cantilever is perpendicular to the longitudinal direction of the cantilever (see Fig. 5) and the mirror reflects light (46) entering microaperture.

Regarding Claims 17-19 (as depending from Claim 1), Brezoczsky et al. teach the probe in a surface observation (for information "reading"- see Col. 1, line 50 to Col. 2, line 5), exposure (for information "writing"- see Col. 1, line 50 to Col. 2, line 5), and information processing (see Col. 7, lines 21-24) system.

Regarding Claim 23, Brezoczsky et al. teach the mirror as having a slanted face (see Fig. 5).

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-4, 9, and 17-19 (as dependent from Claims 2-4 and 9) are rejected under 35 U.S.C. 103(a) as being unpatentable over Brezoczsky et al.

Regarding Claims 2-4 and 17-19 (as dependent from Claims 2-4), Brezoczsky et al. teach the probe as taught in Claim 1, according to the appropriate paragraph above. Regarding Claims 17-19 (as dependent from Claims 2-4), Brezoczsky et al. teach the probe in a surface observation (for information "reading"- see Col. 1, line 50 to Col. 2, line 5), exposure (for information "writing"- see Col. 1, line 50 to Col. 2, line 5), and information processing (see Col. 7, lines 21-24) system. Brezoczsky et al. do not teach the waveguide containing a V-shaped transversal cross section, or a trapezoidal cross section, or a U-shaped transversal cross section. It is well known in the art to use different-shaped waveguide cross sections to direct light as desired. It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the waveguide with a V-shaped, trapezoidal, or U-shaped transversal cross section in the probe of Brezoczsky et al., as such a decision is a matter of design choice and provides no substantial functional improvement.

Regarding Claims 9 and 17-19 (as dependent from Claim 9), Brezoczsky et al. teach the probe as taught in Claim 1, according to the appropriate paragraph above. Brezoczsky et al. also teach (see Fig. 5) a lens (64) to focus the light traveling through the tip. Regarding Claims 17-19

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(as dependent from Claim 9), Brezoczsky et al. teach the probe in a surface observation (for information "reading"- see Col. 1, line 50 to Col. 2, line 5), exposure (for information "writing"- see Col. 1, line 50 to Col. 2, line 5), and information processing (see Col. 7, lines 21-24) system. Brezoczsky et al. do not teach the mirror as a concave mirror. It is well known in the art to use a concave mirror in replacement of a separate mirror and lens to provide simultaneous reflection and focusing properties. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a concave mirror in the probe of Brezoczsky et al., to create a simpler, cost-effective, and more durable construction of the cantilever through fewer, less destructible parts.

8. Claims 5, 7, and 17-19 (as dependent from Claims 5 and 7) are rejected under 35 U.S.C. 103(a) as being unpatentable over Brezoczsky et al. in view of Quate US Patent No. 5,354,985.

Regarding Claims 5, 7 and 17-19 (as dependent from Claims 5 and 7), Brezoczsky et al. teach the probe as taught in Claim 1, according to the appropriate paragraph above. Regarding Claims 17-19 as depending from Claims 5 and 7, Brezoczsky et al. teach the probe in a surface observation (for information "reading"- see Col. 1, line 50 to Col. 2, line 5), exposure (for information "writing"- see Col. 1, line 50 to Col. 2, line 5), and information processing (see Col. 7, lines 21-24) system. Brezoczsky et al. do not teach the tip shaped as a square cone or the cantilever principally composed of silicon. Quate teaches a probe comprising a cantilever (see Fig. 1B) composed of silicon (see Col. 3, line 12), square hollow tip (see Fig. 6D), microaperture (see Abstract, line 5), and waveguide (23). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a square cone tip and a silicon cantilever as

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taught by Quate in the probe of Brezoczsky et al., to better angle the optical beam for greater beam confinement and less optical loss through the cantilever.

9. Claims 10-14, 16, and 20-22 (as dependent from Claims 10-14 and 16) are rejected under 35 U.S.C. 103(a) as being unpatentable over Quate US Patent No. 5,354,985 in view of Yamamoto et al.

Regarding Claims 10-12, 14, and 20-22 (as dependent from Claims 10-12 and 14), Quate teaches a probe comprising a cantilever (see Fig. 1B), hollow tip (see Fig. 6D), microaperture (see Abstract, line 5), and waveguide (23). Quate also teaches the formation of a hollow tip (Fig. 4A-4M) and the removal of a part of a substrate by etching to form a cantilever (Fig. 4L) for an optical probe. Regarding Claim 12, Quate further teaches the use of crystal-anisotropic etching (see Col. 8, lines 31-35) to etch the substrate of a cantilever probe. Regarding Claim 14, Quate teaches the use of a silicon-on-insulator (SOI) wafer as a substrate (see Col. 5, lines 55-58) and the etching of the SOI layer (see Col. 6, lines 12-13). Regarding Claims 20-22 (as dependent from Claims 10-12 and 14), Quate teaches the probe as a surface observation (see Fig. 2 and Col. 1, lines 48-52), exposure (see Col. 1, lines 48-52), and information processing apparatus (see Fig. 2 and Col. 4, lines 30-34). Quate does not teach the construction of the probe by working a substrate to form a groove and a mirror at an end of the groove therein and forming a flat plate-shaped covered portion on the groove. Yamamoto et al. teach (see Fig. 7) a probe comprising a cantilever (15), hollow tip (see Fig. 6b), mirror (8) (see Fig. 3), microaperture (see Col. 2, lines 66-67), and hollow waveguide (see Col. 2, lines 15-16). Yamamoto et al. and Quate do not teach the working of a substrate to form a groove and forming a flat plate-shaped cover portion on the

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groove to form a hollow waveguide. It is well known in the art to etch a substrate and form a covering surface layer to produce a hollow waveguide within the substrate. It would have been obvious to one of ordinary skill in the art at the time the invention was made to produce the probe of Quate with the hollow waveguide of Yamamoto et al. by working a substrate to form a groove, forming a flat plate-shaped cover portion on the groove to form a hollow waveguide, forming a hollow tip having a microaperture, and removing a part of the substrate by etching to form a cantilever, to provide a simplified fabrication process for producing the optical probe and specifically, the cantilever and groove, to provide a waveguide with minimal optical loss.

Regarding Claims 13 and 20-22 (as dependent from Claim 13), Quate in view of Yamamoto et al. teach the method as taught in Claim 10, according to the appropriate paragraph above. Regarding Claims 20-22 (as dependent from Claim 13), Quate teaches the probe as a surface observation (see Fig. 2 and Col. 1, lines 48-52), exposure (see Col. 1, lines 48-52), and information processing apparatus (see Fig. 2 and Col. 4, lines 30-34). Yamamoto et al. also teach a surface treatment step to form a mirror surface state (see Col. 2, lines 64-65 and Col. 3, lines 12-18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to form a mirror surface state as taught by Yamamoto et al. in the method of Quate in view of Yamamoto et al., to construct a precise, well-defined mirror to provide minimal optical loss by maintaining optical confinement from the waveguide.

Regarding Claims 16 and 20-22 (as dependent from Claims 16), Quate in view of Yamamoto et al. teach the method as taught in Claim 10, according to the appropriate paragraph above. Quate also teaches the formation of a hollow tip (Fig. 4A-4M) and the removal of a part of a substrate by etching to form a cantilever (Fig. 4L) for an optical probe. Regarding Claims



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20-22 (as dependent from Claim 16), Quate teaches the probe as a surface observation (see Fig. 2 and Col. 1, lines 48-52), exposure (see Col. 1, lines 48-52), and information processing apparatus (see Fig. 2 and Col. 4, lines 30-34). Quate and Yamamoto et al. do not teach the specific process of forming a film of tip material on a recess, transferring the tip material onto the opening, and etching the end of the tip to form the microaperture. It is common knowledge to form a material into a tip form and etch a microaperture for a cantilever, as using such a production method is well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to create the tip and microaperture in the modified probe of Quate in view of Yamamoto et al. by forming the material into a tip form and etching the microaperture, to utilize a well-known and simple method of producing a tipped cantilever for confined optical emissions and collections.

10. Claims 15 and 20-22 (as dependent from Claim 15) is rejected under 35 U.S.C. 103(a) as being unpatentable over Quate in view of Yamamoto et al., further in view of Tsukamoto et al. US Patent No. 5,902,715.

Quate teaches a probe comprising a cantilever (see Fig. 1B), hollow tip (see Fig. 6D), microaperture (see Abstract, line 5), and waveguide (23). Quate also teaches the formation of a hollow tip (Fig. 4A-4M) and the removal of a part of a substrate by etching to form a cantilever (Fig. 4L) for an optical probe. Regarding Claims 20-22 (as dependent from Claim 15), Quate teaches the probe as a surface observation (see Fig. 2 and Col. 1, lines 48-52), exposure (see Col. 1, lines 48-52), and information processing apparatus (see Fig. 2 and Col. 4, lines 30-34). Quate does not teach the construction of the probe by working a substrate to form a groove therein and

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forming a flat plate-shaped covered portion on the groove. Yamamoto et al. teach a probe comprising a cantilever, hollow tip, microaperture, and hollow waveguide. Yamamoto et al. also teach a forming of a metal film on the outer surface of the probe (see Col. 2, lines 64-65 and Col. 3, lines 12-18). Quate and Yamamoto et al. do not teach a cover portion formed by filling the groove with a resin layer. Tsukamoto et al. teach an optical waveguide with a surrounding cover portion formed by filling a groove with a resin layer (see Col. 50, lines 63-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the waveguide of Quate in view of Yamamoto et al. using a photosensitive resin layer, as taught by Tsukamoto et al., to create the cover portion, so that the cover portion will effectively remain covering a majority of the groove, without requiring a complex etching method to retain the cover portion.

### ***Response to Arguments***

11. Applicant's arguments filed September 25, 2002 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

Regarding Claims 10-16, Quate teaches that light travels through the waveguide (51) (See Fig. 5A) and through the aperture at the end of the tip (see Col. 8, lines 20-25) (note- it appears that the specification section of Quate incorrectly lists reference numeral 54 as the tip instead of tip (52) as defined in Col. 7, lines 64-66, as reference numeral 54 refers to a Cr/Au layer, defined in Col. 7, lines 67-68 which possesses no tip-like properties). Therefore, the tip

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portion does indeed function as an optical path and the orthogonal angle is essential in directing the light downwards through the tip onto a sample surface. Further, since the light traveling through the waveguide is emitted through the aperture at the end of the tip, the metal film (54) is obviously used to redirect the light from its original direction to a downward position and any light reflected off the mirror is still directed into the tip as desired by Quate. Therefore, the combination of the hollow fiber of Yamamoto et al. with the probe and construction method of Quate is deemed obvious.

### *Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Yam whose telephone number is (703)306-3441. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta can be reached on (703)308-4852. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7724 for regular communications and (703)308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

SY

SY  
December 6, 2002

  
**DAVID PORTA**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2800**